

### REMARKS

Claims 32-44 were originally pending in the present application. Of these, claims 32-44 were rejected. For the reasons discussed below, these claims are believed allowable.

### CLAIM REJECTIONS

The Examiner has rejected claims 32-43 under 35 U.S.C. 102(e) as being anticipated by Gradon et al. (U.S. 6,349,722). As specified by the Examiner, the rejections based on Gradon et al. constitute new grounds of rejection (see Office Action, para. 6, p. 3).

Applicant respectfully submits that the Examiner has inappropriately cited to the Gradon patent as a reference for a 35 U.S.C. 102(e) rejection because the U.S. filing date of Gradon is later than the filing date of the instant application. Prior to filing this Response, the Applicants' representative attempted to contact the Examiner by phone to discuss the basis for the above rejection. The Applicants' representative left detailed voice mails regarding this issue but did not receive any response.

Section 102(e) reads:

Conditions for Patentability; Novelty and Loss of Right to Patent

A person shall be entitled to a patent unless –

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for the patent.

The Section has been simply described as a "patent defeating provision," *i.e.*, if the facts of the applicant's case bring him within it, the right to a patent is defeated. See, In re Hilmer, Korger, Weyer and Aumuller, 149 USPQ 480, 484 (1966), citing to Harold S.

Meyer, Are Patents Effective References as of Foreign Filing Dates? June, 1965. As decided by In re Hilmer, according to Section 102(e) a US patent is available to be used as a reference as of its U.S. filing date. In re Hilmer, 149 USPQ at 496.<sup>1</sup> Under section 102(e), the entire disclosure of a U.S. patent having an earlier filing date than the application at issue can be relied on as a "prior art reference" as a basis for rejection of the claims. Determination of the "filing date" has been before the Court of Customs and Patent Appeals. In re Hilmer, Korger, Weyer and Aumuller, 149 USPQ 480 (1966) (attached). In accordance with this case, a U.S. patent reference is effective prior art as of its U.S. filing date, *i.e.*, 35 USC 119(a)-(d) does not modify section 102(e) which is explicitly limited to patent references "filed in the United States before the invention thereof by the applicant" (emphasis added). Id. at 482. Therefore, the critical reference date is the U.S. filing date.

It is true that applications filed in the US may be entitled to the benefit of foreign priority under certain conditions, as specified by 35 USC 119(a) – (d) (MPEP 201.13). The conditions are (a) the foreign application must be filed in a recognized country (that affords similar privileges), (b) by the same applicants, (c) the US application must be filed within 12 months from the date of the first filing in the recognized foreign country, (d) the foreign application must be for the same invention, and (e) if the foreign application is for an inventor's certificate, the applicant must have had the right to apply for either a patent or an inventor's certificate. However, a foreign priority date under 35

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<sup>1</sup>Subsequently, it was held on remand that claimed subject matter may be considered prior art under 102(g), if at all, only as of the US filing date of the application containing the claim, and could not in fact be prior art in the case on remand because the applicant's US filing date preceded that of that patent that has been cited as "prior art." In re Hilmer, Korger, Weyer and Aumuller, 165 USPQ 255 (1970)

USC 119(a)-(d) cannot be used as the 35 USC 102(e) reference date. See, In re Hilmer, Korger, Weyer and Aumuller, 149 USPQ 480 (1966).

With respect to the rejections set forth in the Office Action at issue, as specified on the title page of the Gradon patent, the application for patent was filed on 06/16/98 and the patent issued on 02/26/02. The patent also specifies the following foreign priority dates: 06/17/97 (NZ); 04/27/98 (NZ).

The instant application is a divisional of application serial no. 09/081,186 to Douglas E. Ott, et al., which was filed on 05/19/98 under 37 CFR 1.53(b).

As such, the U.S. filing date of the Gradon patent is later than the filing date of the application at issue, which is 05/19/98 in light of its status as a divisional application under 37 CFR 1.53(b). In accordance with MPEP 201.06(c), which sets forth 37 CFR 1.53(b) and 37 CFR 1.63(d) Divisional-Continuation Procedure, the filing date of an application for patent filed under this section is the date on which a specification containing a description pursuant to 37 CFR 1.71 and at least one claim pursuant to 37 CFR 1.75 and any drawing required by 37 CFR 1.81(a) are filed in the Patent and Trademark Office. In short, the instant application should be entitled to the parent's filing date of 05/19/98.

Given that the U.S. filing date of the Gradon patent (06/16/98) is later than the filing date of the instant application (05/19/98), the Gradon patent cannot be cited as effective prior art with respect to the instant application for a 35 U.S.C. 102(e) rejection.

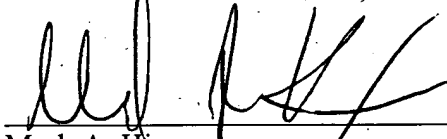
For this reason, Applicant respectfully submits that claims 32-43 should be allowable.

35 USC § 103

The Examiner has further rejected claim 44 under 35 U.S.C. 103(a) as being unpatentable over Gradon et al. (U.S. 6,349,722 B1) in view of Ott et al. (U.S. patent no. 5,411,474). Applicant respectfully submits that the Examiner has again inappropriately cited to the Gradon patent as a reference for a 35 USC 103(a) rejection. It is understood that a U.S. patent may be used as of the filing date of the patent to show that the claimed subject matter is anticipated or obvious. Obviousness can be shown by combining other prior art with the U.S. patent reference in a 35 U.S.C. 103 rejection.

However, as previously explained, the U.S. filing date of the Gradon patent (06/16/98) is later than the filing date of the instant application (05/19/98). For this reason, the Gradon patent cannot be appropriately cited as effective prior art with respect to the instant application. As such, Applicant respectfully submits that claim 44 should be allowable.

Respectfully submitted,

  
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